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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,942	07/26/2001	Daniel C. Castle	10003069-1	8801

7590 05/02/2006

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/916,942

Applicant(s)

CASTLE, DANIEL C.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02/16/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. Claims 1-16 have been examined. Application 09/916,942 (Method and apparatus for increasing on-line publication distribution) has a filing date 07/26/2001.

#### ***Response to Amendment***

2. In response to Non Final Rejection filed 11/16/2005, the Applicant filed an Amendment on 02/16/2006, which amended claims 1, 7, 8, 9, 15 and 16.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (US 2005/0091109) in view of Applicant's background of the invention and further in view of Blaser (US 6,757,661).

As per claims 1-8, Howard teaches:

In an on-line publication ("publication") distributed to a plurality of publication subscribers via a data network, a method of sending to a publication subscriber, at least one of either: paid advertising messages or content advertising messages;

said method comprising the steps of:

reading from a server for said publication, a user profile for the subscriber (see paragraph 8);

*automatically tracking publication distribution to various receipt subscribers* (see paragraph 26) ;

determining the subscriber's publication usage levels from data in said user profile (see paragraph 46);

sending the subscriber a targeted paid advertisement (see paragraphs 50-51);

sending the subscriber a targeted content advertisement for the publication (see paragraph 59), said targeted content advertisement being selected based upon at least one of:

data in said user profile (see paragraph 59); and

advertising space available in said publication for content advertising usage (see paragraph 52); and

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraph 59);

detecting the subscriber's request for continued delivery of said specified content via said data network (see paragraph 39) ;

modifying data in the user profile to reflect the subscriber's request for continued delivery of said specified content (see paragraph 40).

Howard does not expressly teach sending additional electronic publications to a subscriber if said subscriber's usage level is low (i.e. receiving a low level of publications) and sending a product advertisement if said subscriber's usage level is

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high (i.e. receiving a high level of publications). Also, Howard does not expressly teach *wherein the data includes historical data on the subscriber's usage of on-line publications*. However, Blaser teaches a system that target advertisements based upon user's profile and usage history (see Blaser column 9, line 59 – column 10, line 40). Applicant's background of the invention discloses that in on-line publishing, generating advertising revenue remains a top priority and because the advertising revenue that a publisher can generate is usually proportional to the number of subscribers that it can demonstrate to prospective advertisers, increasing the number of subscribers to publications remains a top priority (see Applicant's background of the Invention page 2). Howard teaches an invention that may be used to increase sales of other publications sold by publishers by offering consumers additional electronic publications based upon one or more profile data items in the consumers' profile (see paragraph 59). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Howard would determine a consumer's electronic publication usage level from the consumer's profile (see Howard paragraph 40) and usage history, as taught by Blaser and based upon said usage level would target new subscriptions' advertisements or products' advertisements to said consumer (see Howard paragraphs 58-59). Electronic publishers would be motivated to send new subscriptions' offers to consumers with a low electronic publication usage level in order to target renewal or new publications' subscriptions advertisements to consumers that would have, due to said consumers' low usage level, the time and inclination to subscribe to new publications, therefore, increasing the profit of said publishers by

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increasing the number of subscribers to said publishers' publications. And electronic publishers would be motivated to send products' advertisements, instead of new subscriptions' publications advertisements, to consumers with a high electronic publication usage level in order to allow said publishers to generate profits from consumers that, due to their high usage level, would not subscribe to said publishers' publications but would view said publishers' products advertisements, therefore, allowing said publishers to bill advertisers for said viewing (see Howard paragraph 36).

As per claims 9, 15 and 16, Howard teaches:

In an on-line publication ("publication") distributed to a plurality of publication subscribers via a data network, a method of sending to a publication subscriber, at least one of either: paid advertising messages or content advertising messages;

said method comprising the steps of:

reading from a server for said publication, a user profile for the subscriber (see paragraph 8);

*automatically tracking publication distribution to various recipient subscribers* (see paragraph 26);

determining the subscriber's publication preferences from data in said user profile (see paragraph 42);

sending the subscriber a targeted paid advertisement consistent with the subscriber's determined preferences (see paragraphs 50-51);

sending the subscriber a targeted content advertisement consistent with the subscriber's determined preferences (see paragraph 59). Howard does not expressly

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teach sending additional electronic publications to a subscriber if said subscriber's usage level is low (i.e. receiving a low level of publications) and sending a product advertisement if said subscriber's usage level is high (i.e. receiving a high level of publications) and *wherein the data includes historical data on the subscriber's usage of on-line publications*. However, the same argument made in claim 8 regarding said missing limitation is also made in claim 9.

As per claim 10, Howard teaches:

The method of claim 9 wherein said step of sending a targeted content advertisement is further comprised of the step of

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of:

data in said user profile (see paragraph 59); and

advertising space available in said publication for content advertising usage (see paragraph 52).

As per claim 11, Howard teaches:

The method of claim 9 wherein said step of sending a targeted content advertisement is further comprised of the step of:

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of:

data in said user profile (see paragraph 59); and

advertising space available in said publication for content advertising usage (see paragraph 52); and

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraph 59).

As per claim 12, Howard teaches:

The method of claim 9 wherein said step of sending a targeted content advertisement is comprised of the step of:

selecting a content advertisement for transmission to the user based upon at least one of:

data in said user profile (see paragraph 59); and

advertising space available for content advertising usage (see paragraph 59);

and

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraph 59);

assembling said content advertisement and said sample of the specified content into a data package and transmitting the data package to the subscriber (see paragraph 44).

As per claim 13, Howard teaches:

The method of claim 9 further comprised of the steps of:

detecting the subscriber's request for continued delivery of said specified content (see paragraph 39);

modifying data in the user profile to reflect the subscriber's request for continued delivery of said specified content (see paragraph 40).

As per claim 14, Howard teaches:



The method of claim 9 further comprised of the steps of:

detecting the subscriber's request for continued delivery of said specified content  
(see paragraph 39);

modifying data in the user profile to reflect the subscriber's request for continued  
delivery of said specified content (see paragraph 39);

monitoring the subscriber's usage levels (see paragraphs 36, 46).

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection. The Applicant argues that Howard should not be combined with the Applicant's Background of the Invention because the statement "that advertising revenue that a publisher can generate is usually proportional to the number of subscribers that it can demonstrate to prospective advertisers, increasing circulation...remains a top priority" is a general goal or problem that advertiser address and this statement does not provide any specific answers or solutions to solve the problem or achieve those goals. Therefore, the Applicant argues that disclosure of a problem statement or goal to be achieved to render obvious the Applicant's claimed unique distribution solution based on usage levels, which according to the Applicant, specifically solves the problem or achieves that goal, is improper and is not supported by the patent regulations. The Examiner answers that Applicant's claimed invention is simply targeting advertisement based upon subscriber's usage levels. If said targeting increases publication circulation would be the intended use of Applicant's claimed invention, but is a limitation that Applicant cannot know (i.e. nobody knows the

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future) and cannot claim. Howard teaches an invention that may be used to increase sales of other publications sold by publishers by offering consumers additional electronic publications based upon one or more profile data items in the consumer's profile (see paragraph 59) and Applicant's background of the Invention provides the motivation of why Howard's electronic publisher would determine a subscriber's usage level from the consumer's profile to better target advertisements, where said targeting on usage level would have the intended use of increasing publication circulation, similar to Applicant's claimed invention.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

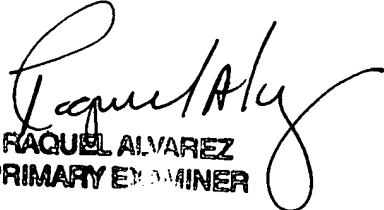
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Lastra  
April 17, 2006

  
RAQUEL ALVAREZ  
PRIMARY EXAMINER